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EXAMINER

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Please find below and/or attached an Office communication concerning this application or proceeding.

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1 RECORD OF ORAL HEARING
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3 UNITED STATES PATENT AND TRADEMARK OFFICE
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5
6 BEFORE THE BOARD OF PATENT APPEALS
7 AND INTERFERENCES
8

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10 *Ex parte* LARRY STEVENS
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13 Appeal 2009-000274
14 Application 09/228,325
15 Technology Center 3700
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18 Oral Hearing Held: April 13, 2010
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21 Before JOHN C. KERINS, STEFAN STAICOVICI, and
22 FRED A. SILVERBERG, *Administrative Patent Judges*.
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25 APPEARANCES:
26

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28 ON BEHALF OF THE APPELLANT:
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1 The above-entitled matter came on for hearing on Tuesday, April 13,
2 2010, commencing at 1:18 p.m., at the U.S. Patent and Trademark Office,
3 600 Dulany Street, Alexandria, Virginia, before Deborah Rinaldo, Notary
4 Public.

5 JUDGE KERINS: Mr. Gilmore, we have reviewed the record of the case and
6 are familiar with the issues, so we're prepared to hear your argument.

7 MR. GILMORE: I'm Rick Gilmore with the law firm of Workman Nydegger
8 in Salt Lake City, Utah. The Applicant in this case is Lifetime Products.

9 Lifetime Products is located in Clearfield, Utah, which is about 30 miles north
10 of Salt Lake City.

11 They make residential basketball systems. In residential basketball systems
12 there's two primary types of residential basketball systems. You can have the
13 in ground systems, which they are permanently attached in the ground, in the
14 poles actually inserted in the ground or portable basketball systems, which
15 there's a base, usually it's blow molded plastic. You can fill it with water or
16 sand and you can move it around, so it's a portable basketball system.

17 The invention is directed towards a basketball backboard for these residential
18 basketball systems. These basketball systems, they have a rigid frame and
19 rebound member. The rebound member is an acrylic sheet. It's attached to
20 that rigid frame.

21 The acrylic sheet is clear because you want to have a professional style
22 looking basketball system. If you go to any NBA game or a college game,
23 they have clear backboards so you can see through them. These residential
24 basketball systems, they want to have that appearance of a professional style
25 basketball system. So you have a clear acrylic sheet attached to that rigid
26 frame.

1 The rigid frame is important because you don't want it to move or flex because
2 you want to have a consistent rebounding so when the basketball it hits the
3 backboard, it bounces off in a consistent way.

4 The claimed invention is directed towards connecting that brittle acrylic sheet
5 to the rigid frame without the acrylic sheet breaking or fracturing. As you
6 looked through the record, the prior art talks about using a double-sided
7 adhesive tape to attach that brittle acrylic sheet to the rigid frame.

8 The application in the prior art talks about doing that with the double-sided
9 tape. The prior art talks about -- and that prior art is by -- our Applicant is
10 Lifetime Products. Their competitor is Huffy Corporation.

11 The Hying patent and the Schickert patent, the ones that are of the record for
12 the basketball system, they are by Huffy, Applicant's competitor in this case.

13 The Hying patent talks about this double-side tape is bad because it doesn't
14 last, it doesn't provide a secure connection between the clear acrylic sheet and
15 the rigid frame; it provides poor rebounding characteristics because of that; it
16 has an exposed edge and that exposed edge is relevant [sic] to crack and break;
17 and it also creates an injury hazard because the falling pieces of acrylic can
18 injure the players.

19 In this case the Examiner committed a reversible error because the claimed
20 invention is not obvious. This is very similar to the prior Board decision. In
21 fact, claims 50 to 53 in this Application are very similar to claim 1, which was
22 previously rejected by the Examiner and the Board previously reversed the
23 Examiner's decision.

24 The other claims are very similar also except in this case the Examiner added
25 three patents to a section 103 rejection. None of these patents, however,
26 related to the situation in which a brittle structure is attached to a rigid frame in

1 which the impact forces have to be dissipated between that brittle acrylic sheet
2 and the rigid frame.

3 In contrast, these three other patents related to different materials for different
4 purposes and they are used in a different environment.

5 KSR also confirms that the invention is not obvious. So in this case the
6 Examiner, he completely discarded what was known in the art at the time of
7 the invention, what the prior art taught, what the predicted result was, what
8 common sense said to do and what this Board previously held.

9 As Chief Judge Fleming said at his conference last week on the Board, it's kind
10 of like two ships passing in the night. So once again, two ships are passing in
11 the night.

12 It might be helpful to put a little time line together. In 1993, the Applicant
13 started using double-sided adhesive tape to attach the brittle acrylic sheet to the
14 rigid frame.

15 In January of 1996 the competitor, Huffy, filed the Schickert patent
16 application. In November of 1996 the competitor, Huffy, filed the Hying
17 patent application. Both the Hying and Schickert -- Hying is a continuation-
18 in-part of Schickert. So that's why they are kind of related.

19 Both of the applications talked about, gee, you shouldn't use double-sided tape
20 for the reasons that it's not strong enough, that over an extended period of time
21 the double-sided tape doesn't work very well, it doesn't sufficiently support the
22 acrylic sheet. So therefore you get poor rebounding performance, you've got
23 an exposed edge and it also creates an injury hazard.

24 In January of 1996 this application was filed and in October of 1999 Applicant
25 Lifetime Products began using the claimed invention, and then in July of 2001
26 competitor Huffy started copying the claimed invention.

1 We talked about instead of using the double-sided adhesive tape which was
2 known in the prior art, the claimed invention is directly connecting that brittle
3 acrylic sheet to the rigid frame using a catalyzed elastomeric adhesive.

4 The Applicant came up with this direct connection using the catalyzed
5 elastomeric adhesive after doing years of R&D. They use a catalyzed
6 elastomeric adhesive because you use a catalyst and the adhesive and you mix
7 them together, and as the application talks about, when you mix them together
8 you can control the cure time. So that's part of the invention.

9 The application also talks about that there's a bond gap and that bond gap is
10 very critical to the invention because it determines -- helped determine the
11 amount of adhesion and flexibility.

12 If the bond gap is too small, then it can't dissipate the energy between the
13 brittle acrylic sheet and the rigid frame. If that bond is too rigid, then the
14 acrylic sheet will fracture. If the bond is too big, then we don't have a secure
15 connection between the two and the acrylic sheet can become disconnected
16 from the rigid frame.

17 So the application talks about that that bond gap is preferably 2 to
18 2.5 millimeters or a little bit less than a tenth of an inch.

19 JUDGE KERINS: Counsel, if we could for a second look to, you had
20 mentioned none of the prior art is -- none of the additional pieces of prior art
21 that were cited subsequent to the prior appeal deal with a similar issue to yours
22 in terms of bonding two items together.

23 I noted specifically one of the two surfboard patents Skedleski is the inventor
24 and it's the '316 Skedleski patent. It talks about attaching the protective tip to
25 the surfboard with a silicone adhesive and it discusses that it is preferable that

1 the space between the tip of the board and the apex of the cover be filled with
2 a silicone adhesive to provide an even further cushioning effect.

3 Isn't that what you are after here with your backboard?

4 MR. GILMORE: No, I think actually that would be inoperative with the
5 claimed invention. What that does is you've got the resilient safety tip that you
6 are putting on the end of the surfboard. So it's not a brittle acrylic structure
7 attached to a rigid frame.

8 It does say that you can put some extra adhesive in there to fill that extra gap.

9 However, the problem is, though, then that would be way too large. We're
10 talking about 2 to 2-1/2 millimeters of a bond gap and the application talks
11 about, gee, if that bond gap is too big, as Skedelecki talks about filling the
12 space between the safety tip and the surfboard, if you fill that space with an
13 adhesive, that would be way too big and you wouldn't have the secure
14 connection between the acrylic sheet and the rigid frame.

15 JUDGE KERINS: More generally, isn't that a teaching that the silicone
16 adhesive will provide cushioning properties and lead us toward the Dow
17 Corning reference which discloses that the cured product is like a rubber-like
18 material and that it would be something you would look to, to use in place of
19 the double-sided tape?

20 MR. GILMORE: I don't think so. I think the double-sided tape teaches, gee,
21 you have to have this foam core, you have to have the cushioning between
22 those two.

23 And the other prior art teaches -- the Schickert and Hying say, gee, if there's
24 problems with the double-sided tape, you shouldn't go with that route; you
25 should use a mechanical way of connecting those two together.

1 So I don't think that what you are talking about is, gee, if you just filled the
2 space between Skedelecki, that's not going to work because you are not going
3 to have that critical bond gap space that the application talks about and you
4 don't have that catalyzed elastic material that the application talks about.

5 JUDGE KERINS: Well, your broadest claims don't claim the bond gap.

6 MR. GILMORE: Some of the narrow claims do talk about the bond gap and
7 talks about -- the Examiner also talks about the application doesn't talk about
8 how critical the bond gap in things is. But yet, actually, the application does
9 talk about that.

10 JUDGE SILVERBERG: Counsel, looking at the Dow Corning reference, does
11 it not say that when it's cured, in the box in the middle of the figure, that it acts
12 like flexible rubber and would not the double adhesive tape have adhesive on
13 both sides and a flexible core at which would be the flexible rubber in this
14 case? Wouldn't they be of similar consistency and operate in the same
15 manner?

16 MR. GILMORE: I don't think necessarily so. I think what the Dow Corning
17 reference does is it says flexible rubber, but someone skilled in the art back in
18 that time, they would not have thought because flexible rubber to me means,
19 gee, you need a secure connection between the brittle acrylic sheet and the
20 rigid frame.

21 To me that doesn't indicate that you are going to have a secure connection.

22 Flexible rubber means to me that you are going to have some movement and
23 shifting between it. So I don't think it does.

24 I think the Dow Corning, that reference was actually disclosed in the
25 application because that's what's preferred to use is that Dow Corning silicone.

1 So what you are doing is, I think looking backwards and saying, gee, if we
2 combine those two as what's shown in the application, we get that. But
3 someone back at that time skilled in the art would say, no, we need the layer of
4 cushioning between it, and just because it's a flexible rubber type when it's
5 cured, I don't think that that would get them there.

6 JUDGE SILVERBERG: When you look at the double-side tape, you've got
7 the cushioning in the middle and although you stated that it wouldn't last, it
8 doesn't have the longevity of your particular invention, but the double-sided
9 tape has adhesive on both sides and a flexible material in the center.

10 When you take the Dow Corning, you've got adhesive on both sides and when
11 cured, a flexible center. Function similar, no, yes?

12 MR. GILMORE: I think what you're doing is -- I think looking back but at
13 that time someone at that time, at the time of the invention would have looked
14 back and said, no, what you need -- you can't just connect -- what the invention
15 is, is directly connecting that brittle acrylic sheet to the rigid frame.

16 I don't think so. Someone back in that time would have said, gee, you need
17 this flexible core between them, and just that the silicone, the Dow Corning
18 reference, that's what the claimed invention is.

19 No one would have thought you could directly connect those two together
20 because you had to dissipate that energy between those two.

21 So what the prior art always taught was, gee, you had to have this actual
22 cushioning between those by the foam core, the double-sided adhesive tape.

23 Or you go to the other structures, the Hying and Schickert, and they would
24 show that you have to have a mechanical structure to hold that, and not only a
25 mechanical structure to hold it, you need a gap between that rigid frame and
26 the brittle acrylic sheet so that it can bend and flex.

1 JUDGE KERINS: Counsel, doesn't the disclosure in Dow Corning that it has
2 the properties of flexible rubber, doesn't that connote to a person skilled in the
3 art back at the time that there would be the energy dissipation through the
4 resiliency of the material?

5 MR. GILMORE: I don't think so. I think what that would connote to
6 someone, gee, a flexible rubber, that doesn't indicate that they're going to have
7 this secure connection that's required between the brittle acrylic sheet and the
8 rigid frame.

9 The flexible rubber would indicate, wait, we don't have that secure connection
10 between it. Also, I don't think it indicates that it has that secure connection
11 that's required for the proper rebound and performance and, two, it doesn't
12 indicate that it's going to have -- what you need to do is have that impact force
13 so that energy of when the basketball hits or when somebody dunks on a
14 basketball system, that's a lot of force that's being applied.

15 I don't think just the two words "flexible rubber" would indicate that someone
16 skilled in the art would say it will dissipate all that impact force being applied
17 to the brittle acrylic sheet attached to the rigid frame.

18 JUDGE KERINS: But then we get back to the surfboard reference which talks
19 about the cushioning effect being obtained by the use of a silicone adhesive.

20 MR. GILMORE: Right, but it's talking about filling the gap between that
21 protective tip and the actual surfboard, which as the specification talks about,
22 gee, it's very careful -- that the gap is something that's very important and the
23 gap size is very important.

24 So it's talking about something that's much bigger and something that wouldn't
25 be operative because you couldn't just fill the space as it's talking about and

1 then have it work in a way that would work in this environment of a basketball
2 backboard.

3 JUDGE KERINS: If you can indulge me, I would like to further explore. The
4 Examiner pointed out two avenues under KSR by which these claims might be
5 obvious and you have countered that the avenues have turned into dead ends. I
6 enjoyed the word selection.

7 You said that you would not get the expected or predictable result of obtaining
8 the same amount of energy absorption and I don't see evidence of that.

9 MR. GILMORE: Well, I think someone back in that time, someone skilled in
10 the art at the time of the invention, what they would have thought was, gee,
11 you have to have this foam core between the brittle acrylic sheet and the rigid
12 frame.

13 Or the prior art taught that's not a good solution. What you should go is
14 towards these mechanical ways of having an interference fit holding on the
15 edges, allowing it to flex and move.

16 So nothing ever talked about directly connecting the two together. In fact, I
17 think it teaches away from directly connecting the two together. The
18 Examiner in his Answer, I think on page 12, admitted that the Hying reference
19 teaches away from the claimed invention.

20 JUDGE SILVERBERG: Excuse me, if I may. The claim calls for adhesion
21 and flexibility, correct?

22 MR. GILMORE: Um-hum.

23 JUDGE SILVERBERG: And the Dow Corning and also the surfboard is
24 talking about adhesion and flexibility. Can you provide us with a basis why
25 that surfboard tip would not lead one to say, okay, we've got silicone which is
26 giving us adhesion and flexibility because it's giving a resilient tip and we

1 couldn't use the Dow Corning reference with a backboard because it's calling
2 for adhesion and flexibility?

3 So why would not the surfboard be bridging the gap between those two pieces
4 of prior art to lead one of ordinary skill to substitute the silicone of Dow for
5 the double-sided tape that's admitted prior art?

6 MR. GILMORE: I think you are connecting different materials for different
7 purposes in a different environment. Different materials in that the safety tip is
8 a flexible -- I can't remember what it is in Skedelski but a flexible material.
9 So it's certainly not a rigid -- it's not connecting a brittle acrylic sheet to a rigid
10 frame. So what it is, is connecting a safety tip to the end of the surfboard and
11 it says to fill that gap with an adhesive.

12 So I think it's different materials. The purposes are different too because in
13 that case the safety tip is the part that it's absorbing the impact in a different
14 way than what the backboard is. The backboard is, you know, the brittle
15 acrylic sheet attached to a rigid frame and that's the adhesive that has to
16 provide both adhesion and the cushioning.

17 Back at the time of the invention, no one ever thought you could directly
18 connect those two together. Instead, everyone else thought you had to have
19 that cushioning between it or you had to have some gap between the two so
20 that you could allow that acrylic sheet to bend and flex because otherwise, that
21 brittle acrylic sheet is going to fracture and break.

22 JUDGE KERINS: Counsel, you saw fit to file declaratory evidence on a
23 couple of issues but we see nothing in the evidence about what a person skilled
24 in the art would have thought about using a flexible rubber-type adhesive
25 versus using a double-sided tape.

1 MR. GILMORE: Well, I think the prior art teaches that -- the prior art says
2 that you should use the double-sided adhesive tape with the foam core to
3 provide that cushioning or, the prior art says, you should use the mechanical
4 connections as the interference fit to do that.

5 I think that if you look at what the Examiner said, he had a couple of
6 conclusionary statements under KSR, but none of those really support it
7 because he talked about, gee, the double-sided tape was costly and time
8 consuming.

9 Well, no one ever knew that until the Applicant came along with his invention.
10 Also, the Examiner also talks about that you look in the adhesive art but the
11 prior art teaches -- the Hying and Schickert patents teach, no, you shouldn't do
12 that; you should go away from doing the double-sided tape; you should go
13 towards the mechanical connection, allowing that because you need to have
14 the gap or you need to have that interference fit so that you don't break the
15 acrylic sheet.

16 As we talked about earlier, the three references that are cited, those are
17 different materials for different purposes in different environments and the
18 expected result was that if you directly connect the rigid frame and the brittle
19 acrylic sheet, if you directly connect those, the expected result was it was
20 going to break.

21 JUDGE KERINS: We see no evidence of that in the record as evidence.

22 MR. GILMORE: I understand your point, but I think someone back in that
23 time, they would have understood that, gee, I connect a brittle structure to a
24 rigid frame, when something impacts that, it's going to cause it to break.

25 I understand your point, but I think someone skilled in the art would have
26 understood that for the testing, if you look at the Ward declaration where they

1 talked about testing these basketball systems, what they do is they take the
2 board and they test it by 75 different times firing a basketball at it at 35 miles
3 an hour.

4 So those are sufficient -- there's a lot of force that hit these backboards. We've
5 all seen pictures of when a professional player dunks on it and breaks a
6 backboard. When they shatter and break, there's a lot of force being applied to
7 it. So someone back at that time skilled in the area would recognize there's a
8 lot of force being applied to these backboards and if they are directly
9 connected, then that acrylic sheet is going to break.

10 JUDGE KERINS: I do have one question about the Ward Declaration which
11 you just referenced. What particular area of secondary considerations is that
12 attempting to give us evidence of?

13 MR. GILMORE: Well, I think the intent was -- this was a transferred case.
14 So I'll put in a little disclaimer there. I think what they were trying to show
15 was that there was some commercial success.

16 What had happened was back at the time when they first started using adhesive
17 tape in, I think it was 2000, they sold 300,000 and then the next year 400,000.
18 What they are trying to show with that is there was some commercial success.
19 It was due at least in part to the fact that instead of using this labor and time
20 intensive double-side adhesive tape, what it did was it allowed you to save
21 some manufacturing costs because 12 people can assemble 2,400 boards in a
22 day rather than 24 people required to assemble 1,800 boards. So there's at
23 least some commercial success due to the fact that you had some savings in
24 cost and savings of labor.

25 The other Declaration was the Nye Declaration and that shows that, gee, there
26 was copying. What had happened was back in '93 we started using the

1 double-sided tape and in 1999 we started using the claimed invention rather
2 than the double-sided tape.

3 Huffy, which is Lifetime's biggest competitor, in 2001 switched from the
4 double-sided tape to using our claimed invention.

5 It was interesting to note that I think that also shows a long-felt need because
6 Huffy filed these two other applications, Hying and Schickert, and said you
7 should use this mechanical way of connecting the two together. And instead
8 of going that way, with the mechanical way, they switched and they copied our
9 way of doing it. So I think that shows a long-felt need.

10 So I think the Nye Declaration both shows copying and long-felt feed and I
11 think the attempt for the Ward Declaration was to show that, gee, at least in
12 part it is due to its commercial success.

13 JUDGE KERINS: As far as the Nye Declaration goes, you do agree at least in
14 terms of copying, you need to show evidence of the copying of the claimed
15 invention. I don't see that the testimony here or the evidence is commensurate
16 in scope with what you have claimed. Is that not the case?

17 MR. GILMORE: I think what the Nye Declaration was just trying to say is,
18 gee, instead of Huffy for years and years -- Huffy and Lifetime, the assignee of
19 the application, they are the two biggest players in the residential basketball
20 system.

21 And Huffy, for years, used the double-side tape. They filed these two other
22 applications to use it a different way but they continued to use the
23 double-sided tape. And then about a year and a half after Lifetime switched
24 from the double-sided tape to adhesive, then Huffy switched and did the same
25 thing.

1 JUDGE KERINS: If you have nothing further for us, we would be happy to
2 take the case under advisement. Thank you.

3 Whereupon, the proceedings at 1:40 p.m., were concluded.
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